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In re application of

Takahiro Yajima et al.

Serial No. 09/769,328

Filed: January 26, 2001

For: DEPOSITED-FILM FORMATION APPARATUS, AND DEPOSITED-FILM FORMATION
PROCESS

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF
THE OFFICE ACTION mailed June 12, 2003.

On November 29, 2002, a first office action was mailed by the examiner, rejecting all of the claims
present in the application. Applicants responded to this office action with a response filed on April
7, 2003. A final rejection was then mailed on June 13, 2003. A response was filed by applicants to
the final rejection on December 12, 2003. An advisory action refusing entry of the amendment was
mailed on June 16, 2004.

On August 5, 2003, the instant petition under 37 CFR 1.181 was timely filed to formally request the
withdrawal of finality of the June 12, 2003 office action. The Office apologizes for the delay in
answering of the instant petition.

Applicant's position for the withdrawal of the finality is that the new grounds of rejection applied by
the examiner in the final rejection were not necessitated by applicant's amendments to the claims.

DECISION

37 C.F.R. 1.116 (b) states:

"§ 1.116 Amendments after final action or appeal.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex
parte reexamination filed under § 1.510, or an action closing prosecution (§
1.949) in an inter partes reexamination filed under § 1.913, amendments may be
made canceling claims or complying with any requirement of form expressly set
forth in a previous Office action. Amendments presenting rejected claims in better
form for consideration on appeal may be admitted. **The admission of, or refusal to
admit, any amendment after a final rejection, a final action, an action closing
prosecution, or any related proceedings will not operate to relieve the application
or patent under reexamination from its condition as subject to appeal or to save
the application from abandonment under § 1.135, or the reexamination from
termination.** No amendment can be made in an inter partes reexamination
proceeding after the right of appeal notice under § 1.953 except as provided for
in paragraph (d) of this section." (emphasis added)

The Final Rejection, mailed April 22, 2002, clearly states that "Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)." The rejection also states "In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action."

Although Applicants did timely file an amendment in response to the final rejection mailed June 12, 2003, the amendment did not place the case in condition for allowance. Consequently, this application became abandoned by operation of law (35 U.S.C. 133) for applicants' failure to timely file a Notice of Appeal in response to the outstanding final rejection. See Lorenz v. Finkl, 333 F.2d 885, 891, 142 USPQ 26, 30 (CCPA 1964).

Given the finality of the rejection in the instant application, the only courses of action available to the applicant as the end of the 6-month statutory period approached would have been:

- (1) To file an amendment, and ensure that it was matched with the file and considered by the Examiner, with the proper extension of time fee, under 37 C.F.R. 1.116, which placed the application in condition for allowance, see MPEP 706.07(f);
- (2) File a notice of appeal with the proper extension of time fee, see MPEP 1205;
- (3) File a continuing application under 37 C.F.R. 1.53(b) or (d), see MPEP 201.06(c) and (d),
- (4) File a request for continued examination under 37 C.F.R. 1.114, or;
- (5) Abandon the application.

When applicants did not receive a response before the expiration of the six month statutory period to respond to the final Office action of April 22, 2002, the appropriate action would have been to (1) inquire as to the status of the application, or (2) file a Notice of Appeal (or a continuing application or request for continued examination) to maintain pendency of the application.

While the Office attempts to promptly match with the application file and respond to any incoming papers, there are those instances where delays do occur, as in the instant application. However, it is clear from 37 C.F.R. 1.116 that abandonment of an application is risked when an amendment after a final Office action is proffered by the applicant. The rule clearly indicates that the mere filing of an amendment does not relieve petitioner of the duty of taking appropriate action to save the application from abandonment.

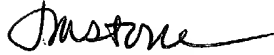
In addition, while it is noted that the instant petition was timely filed prior to the application becoming abandoned, the petition does not prevent the application from becoming abandoned.

Section (f) of Rule 181 states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

On its face, the instant petition appears to have merit. However, because the instant application is now abandoned, the petition is moot. Accordingly, the petition for withdrawal of finality is **DISMISSED.**

If a petition to revive the instant application is filed and subsequently granted, then applicants may request reconsideration of the instant petition decision.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112